

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:) Confirmation No.: 7829
Koichiro TANAKA) Examiner: Maria A. Elve
Serial No. 10/721,075) Group Art Unit: 3742
Filed: November 26, 2003)
For: LASER IRRADIATION APPARATUS,)
LASER IRRADIATION METHOD,)
AND METHOD FOR)
MANUFACTURING A)
SEMICONDUCTOR DEVICE)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The present *Request* is filed pursuant to the provisions of the Pre-Appeal Brief Conference Pilot Program (1296 Off. Gaz. Pat. Office 67 (July 12, 2005); extended January 10, 2006). The Official Action mailed March 16, 2010 and Advisory Action mailed June 28, 2010, have been received and their contents carefully noted. Filed concurrently herewith is a *Notice of Appeal*. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. The review is requested for the following reasons. The Official Action includes improper rejections, errors in fact and omissions of essential elements required to establish a *prima facie* rejection. Specifically, the Official Action appears to deny the priority of the present application based on a flawed analysis of the Applicant's Verified English Translation. Furthermore, the Official Action fails to apply any intelligible standard under which the Translation is to be reviewed.

The Official Action rejects claims 1, 2, 4-11 and 13-18 as obvious based on the combination of U.S. Patent No. 6,700,096 or U.S. Publication No. 2003/0136772 to Yamazaki; Australian Patent Publication No. AU 2003220835 to Otsu and U.S. Patent No. 6,014,401 to Godard. The Official Action rejects claims 19, 20, 22-29, 31-38, 40-47 and 49-54 as obvious based on the combination of Yamazaki '096, Otsu, Godard, U.S. Patent No. 6,242,292 to Yamazaki and U.S. Patent No. 7,132,375 to Yamazaki.

The Official Action appears to reject the Applicant's Verified English Translation (Translation) of the priority document JP-2002-349007, asserting that "the translated text appears to contradict applicant's figures." The Applicant respectfully disagrees and asserts that the Official Action commits significant errors of fact in its analysis. The Translation does not contradict the Figures of the subject application and the proper focus of the inquiry should be on whether the Translation provides support for the subject matter claimed in the present application.

The Official Action commits errors of fact by asserting that the Translation contradicts the figures of the subject application. The Translation does not contradict the Figures of the subject application. Specifically, Figure 1A illustrates the overlap of a portion of beam spot 10 with the area of beam spot 11. The text portion of the Translation of the priority document corresponding to the above-mentioned illustration states that, for example, "[the] area of the region in which the beam spot 10 of the continuous oscillation YAG laser having a fundamental wave and the beam spot 11 of the continuous oscillation YAG laser having a second harmonic are overlapped corresponds to the area of the beam spot 11 when it is assumed that the beam spot 11 completely overlap the beam spot 10" (emphasis added). Likewise, Figure 1B illustrates the overlap of a portion of beam spot 12 with the area of beam spot 10. The corresponding text of the Translation states that "[the] area of the region in which the beam spot 10 of the continuous oscillation YAG laser having a fundamental wave and the beam spot 12 of the pulse oscillation excimer laser are overlapped corresponds to the area of the beam spot 10 when it is assumed that the beam spot 10 completely overlap the beam spot 12" (emphasis added). It is respectfully submitted that the important feature – that the areas of the regions of overlap correspond to the areas of beam spot 11 and beam spot 10, respectively – is described clearly in the Translation

and would be understood by one of ordinary skill in the art in a manner that is consistent with the Figures.

The Official Action commits further errors of fact in misquoting the Translation, removing the relevant context and disregarding portions thereof most relevant to the features of the claimed invention. Apparently as justification for denying the benefit of JP-2002-349007, the Examiner appears to assert that a portion of the Translation, which is peripheral to this important feature, taken out of context, and then misquoted, contradicts the Figures. Specifically, the Examiner asserts that “the text states: ‘when it is assumed that the beam spot 11 completely overlaps the beam spot 10’” and that “the text states: ‘the spot 10 completely overlaps the beam spot 12.’” Apparently, the Examiner has omitted key portions of the relevant text, and modified the remaining text to suggest something other than what is actually disclosed in the Translation. However, as noted above, the actual text states that “[the] area of the region in which the beam spot 10 of the continuous oscillation YAG laser having a fundamental wave and the beam spot 11 of the continuous oscillation YAG laser having a second harmonic are overlapped corresponds to the area of the beam spot 11 when it is assumed that the beam spot 11 completely overlap the beam spot 10” and that “[the] area of the region in which the beam spot 10 of the continuous oscillation YAG laser having a fundamental wave and the beam spot 12 of the pulse oscillation excimer laser are overlapped corresponds to the area of the beam spot 10 when it is assumed that the beam spot 10 completely overlap the beam spot 12.” In other words, the text discloses that when beam spots 11 and 10 are completely overlapped, the area of overlap corresponds to the area of beam spot 11, and when the beam spots 10 and 12 are completely overlapped, the area of overlap corresponds to the area of beam spot 10.

However, the Examiner’s interpretation that “the text states: ‘when it is assumed that the beam spot 11 completely overlaps the beam spot 10’” and that “the text states: ‘the spot 10 completely overlaps the beam spot 12’” is not supported by the actual text. The text neither states that the beam spot 11 completely overlaps the beam spot 10, nor does it state that the spot 10 completely overlaps the beam spot 12. In any event, as noted above, the important feature conveyed by this portion of the specification, which is omitted in the excerpt of the Translation asserted by the Examiner, is that the areas of the regions of overlap correspond to the areas of

beam spot 11 and beam spot 10. It is respectfully submitted that one of ordinary skill in the art, would understand the portion of the sentences that the Examiner has chosen to omit and, accordingly, would understand the Translation in its totality in a manner consistent with the Figures.


Moreover, the proper focus of the inquiry should be on whether the Translation provides support for the subject matter claimed in the present application. It is respectfully submitted that the Official Action fails to apply a proper standard for analyzing the Translation. Specifically, the Applicant notes that, under MPEP § 201.15, the Translation is to be considered for “sufficiency of the disclosure under 35 U.S.C. § 112” and “to determine if there is a basis for the claims sought.” This analysis is not satisfied by the mere assertion that “the translated text appears to contradict the applicant’s figures,” aside from the above-mentioned absence of any such contradiction. The Applicant respectfully submits that the translated specification, when read in its entirety, would have conveyed to one of ordinary skill in the art, at the time of the invention, possession of the claimed invention under 35 U.S.C., § 112. Furthermore, under a proper analysis, it is respectfully submitted that one of ordinary skill in the art would readily understand that the Figures illustrate what is described in the above-mentioned direct translations of the priority document. That is, as shown in Figure 1A, the Translation conveys that the entirety (i.e., “the area”) of beam spot 11 is overlapped when the beam spots 10 and 11 completely overlap (as opposed to only partially). As shown in Figure 1B, the document conveys that the entirety of beam spot 10 is overlapped when the beam spots 10 and 12 completely overlap.

Accordingly, the Applicant respectfully submits that the Official Action commits substantial errors of fact in denying the Applicant’s priority, and further submits that Translation of priority application JP 2002-349007 filed November 29, 2002, is proper and supports what is claimed in the subject Application. Since Otsu has a publication date of September 22, 2003, which is later than the filing date of JP ‘007, the Applicant again respectfully submits that the rejections under § 103 should be overcome. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103 are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

The Commissioner is hereby authorized to charge fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(a), 1.20(b), 1.20(c) and 1.20(d) (except the Issue Fee) which may be required now or hereafter, or credit any overpayment to Deposit Account No. 50-2280.

Respectfully submitted,



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